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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/633,555

08/05/2003

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1405.1073

7151

21171 7590 06/08/2009  
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EXAMINER

WHIPPLE, BRIAN P

ART UNIT

PAPER NUMBER

2452

MAIL DATE

DELIVERY MODE

06/08/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/633,555	<b>Applicant(s)</b> OHNO ET AL.	
	<b>Examiner</b> BRIAN P. WHIPPLE	<b>Art Unit</b> 2452	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-11,13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-11,13 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/5/09</u> .  | 6) <input type="checkbox"/> Other: _____                          |

#### DETAILED ACTION

1. Claims 1, 3-11, and 13-14 are pending in this application and presented for examination.

#### *Response to Arguments*

2. Applicant's argument, see page 8, filed 5/5/09, with respect to the 35 U.S.C. 112, second paragraph rejections of claims 1-2 and 10-11, has been fully considered and is persuasive. The 35 U.S.C. 112, second paragraph rejections of claims 1-2 and 10-11 have been withdrawn.

3. Applicant's argument, see page 10, filed 5/5/09, with respect to the 35 U.S.C. 102 rejection of claim 5, has been fully considered, but it is not persuasive.

Applicant argues that the decision is not based upon a distribution history. The Examiner respectfully disagrees and points the Applicant to Col. 9, ln. 25-29 of Sugano, which states: "the originator of the user information (or providing user) may refers to the transmission history and can confirm, in full, activity of other user who have received user information related to the originating user"; and

Col. 18, ln. 10-14 of Sugano, which states: “When changes are made in user information... an update notification is transmitted to each of the user terminals... corresponding to receiving users who previously received a corresponding transmitted UIO.”

4. Applicant's remaining arguments have been considered, but are directed to the amended subject matter. Applicant generally argues the amended subject matter is not disclosed by Sugano. The Examiner respectfully disagrees and points Applicant to the rejection below which provides citations of Sugano for the amended subject matter.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3-11, and 13-14 are rejected under 35 U.S.C. 102(b) as anticipated by Sugano et al. (Sugano), U.S. Patent No. 6,205,478 B1.

7. As to claim 1, Sugano discloses a client administration method of administering a group of clients (Abstract, ln. 1-3), each client providing presence information (Col. 7, ln. 47-49), the method comprising:

accepting a setting of presence information of the clients including a first client, and storing the presence information on a client by client basis (Col. 7, ln. 40-43 and 47-49; Col. 19, ln. 2-6);

storing a watcher list for each of clients in the clients group (Col. 24, ln. 37-43; Col. 27, ln. 55-66; Col. 29, ln. 20-23 and 34-36), the watcher list correlating at least one identifier of a watcher client with an identifier of a client owning the watcher list (Col. 16, ln. 28-30; Col. 24, ln. 37-43; Col. 27, ln. 55-66; Col. 29, ln. 20-23 and 34-36), each watcher client being provided with the presence information of a client owning the watcher list (Col. 18, ln. 65 – Col. 19, ln. 2; Col. 24, ln. 37-43; Col. 27, ln. 55-66; Col. 29, ln. 20-23 and 34-36);

accepting a change of an identifier of the first client (Fig. 2, item 7; Col. 19, ln. 12-25);

deciding at least one of watcher clients of the first client to be one or more identifier notification recipients according to the change of the identifier of the first client (Fig. 2, item 7; Col. 19, ln. 12-25; Col. 23, ln. 36-43);

replacing, in a watcher list of the first client, an old identifier of the first client with a new identifier, and replacing identifiers of all watcher clients with an at least one identifier

of the decided notification recipients (Col. 22, ln. 19-22; Col. 24, ln. 37-43; Col. 27, ln. 55-66; Col. 29, ln. 20-23 and 34-36), and

transmitting a new identifier of the first client to one or more identifier notification recipients identified in said deciding (Col. 22, ln. 6-18; Col. 23, ln. 36-43).

8. As to claim 3, Sugano discloses storing identifiers of subscriber clients so that each subscriber client is associated with at least one client that provides the presence information thereto, the subscriber client being provided with the presence information of at least one client of the clients group (Col. 7, ln. 47-49; Col. 16, ln. 28-30; Col. 18, ln. 65-67; Col. 19, ln. 1-2; Col. 27, ln. 55-66); and

deciding a client to be an identifier notification recipient, the client being both a watcher client of the first client and a subscriber client of the first client (Col. 23, ln. 36-43).

9. As to claim 4, Sugano discloses notifying the first client's watcher client of new presence information according to the setting of the presence information (Col. 7, ln. 47-49; Col. 26, ln. 12-41);

storing a notification history of the presence information (Col. 9, ln. 25-29; Col. 22, ln. 65-67; Col. 23, ln. 1-3); and

said deciding including extracting at least one of a plurality of watcher clients of the first client based on the notification history, and deciding to be one or more identifier notification recipients (Col. 18, ln. 10-14; Col. 19, ln. 12-25; an update notification is transmitted to each of the user terminals corresponding to receiving users who previously received a corresponding transmitted UIO; transmitting based on previous recipients is a decision step based on notification history).

10. As to claim 5, Sugano discloses administering distribution of text messages exchanged between the clients (Fig. 3; Col. 21, ln. 39-48);

storing a distribution history of distributed text messages (Fig. 3; Fig. 4; Col. 9, ln. 25-29; Col. 18, ln. 10-14; Col. 22, ln. 65-67; Col. 23, ln. 1-3); and

said deciding including extracting at least one of a plurality of watcher clients of the first client based on the distribution history, and deciding to be one or more identifier notification recipients (Col. 18, ln. 10-14; transmitting based on previous recipients is a decision step based on distribution history).

11. As to claim 6, Sugano discloses said storing of the presence information of the clients includes associating the presence information with an access level, the access level limiting

notification recipients of the presence information of the clients (Col. 19, ln. 63-67; Col. 20, ln. 1-15);

the access level of each watcher client (Col. 19, ln. 63-67; Col. 20, ln. 1-5) is stored;  
and

a portion of a plurality of watcher clients of the first client is determined to be the identifier notification recipients based on the access level of each watcher client (Col. 20, ln. 30-61; Level 5 users are not issued a UIO and no items are accessible).

12. As to claim 7, Sugano discloses transmitting display data for displaying the change of the identifier of the first client to one or more identifier notification recipients (Col. 25, ln. 19-36).

13. As to claim 8, Sugano discloses transmitting attribute information related to the change of the identifier of the first client to one or more identifier notification recipients (Fig. 3; Col. 22, ln. 6-18).

14. As to claim 9, Sugano discloses accepting registration of the attribute information (Col. 22, ln. 19-22).



15. As to claims 10-11 and 13-14, the claims are rejected for reasons similar to claim 1 above.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Coutts et al. (Coutts), U.S. Publication No. 2003/0120732 A1 outlines that buddy lists in the instant messaging art were known to be able to include detailed presence information. In fact, Coutts was filed on 12/20/01 and lists the buddy lists and related presence in the "BACKGROUND OF THE INVENTION" section, which outlines the prior art at the time of the invention.

Coutts discloses storing a watcher list for each of clients in the clients group ([0020]), the watcher list correlating at least one identifier of a watcher client with an identifier of a client owning the watcher list ([0002]; [0042]), each watcher client being provided with the presence information of a client owning the watcher list ([0002]; [0042]); and

replacing, in a watcher list of the first client, an old identifier of the first client with a new identifier, and replacing identifiers of all watcher clients with an at least one identifier of the decided notification recipients ([0002]; [0043]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize Coutts in the aforementioned manner in order to provide varied presence information to instant messaging contacts depending on the context ([0043]).

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN P. WHIPPLE whose telephone number is (571)270-1244. The examiner can normally be reached on Mon-Fri (9:30 AM to 6:00 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Art Unit: 2452

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6/1/09

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